

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE	
First Named Inventor :	Victor ChiSiang Choo
Appln. No.:	10/791,051
Filed :	March 2, 2004
For :	A CLAMP OR CLAMP ASSEMBLY HAVING A LOW PROFILE
Docket No.:	STL 11375 (S104.12-0048)
	Group Art Unit: 3729 Examiner: Paul D. Kim

Electronically Filed: April 30, 2009

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant respectfully requests a Pre-Appeal Brief Review of the rejection of claims 17-19 and 31 under 35 U.S.C. § 112 and the rejection of claims 21-23, 25-29, 32-33, 35, 38 and 41-44 under 35 U.S.C. § 103 as being anticipated by Ng, U.S. Patent No. 7,215,509, since the rejections are either based on clear errors of fact and/or omission of essential elements to establish a *prima facie* rejection as follows.

The Office Action fails to establish a *prima facie* basis to reject claims 17-19 and 31 under 35 U.S.C. § 112, 2nd paragraph

The Office Action states that claims 17-19 and 31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, 2nd paragraph. The Office Action is completely silent regarding any rejection of claims 17-19 and 31 under 35 U.S.C. § 112, 2nd paragraph. Clearly the Office Action fails to establish a *prima facie* basis to reject claims 17-19 and 31 under 35 U.S.C. § 112.

Rejection of claim 21 is clearly erroneous based upon a mischaracterization of the Ng reference

Claim 21 recites a method comprising *inter alia*:

supplying an outward force in a **first direction** . . . to enlarge an opening defined by the clamp;

supplying a **clamping force in a second direction generally transverse to the first direction** to **disengage the inner portion of the clamp** from the assembly tool, **thereby reducing the opening to install the clamp over a flange** of a clamping interface.

Rejection of claim 21 on the basis that Ng discloses “supplying an outward force in a first direction (194, downward Y-direction) via contacting engagement . . . against an inner portion (154) of a clamp (200)” and “supplying a clamping force in a second direction (196, X-direction) generally transverse to the first direction to disengage the inner portion of the clamp from the assembly tool thereby reducing the opening to install the clamp over a flange of a clamping interface (138) as shown in Figs. 10-12 (see also col. 7, line 13 – col. 8, line 38)” on page 2 of the Office Action is clearly erroneous. Further the statement on page 5 of the Office Action, that in Fig. 9, “[a]fter the clamp is supplied outward force in the first Y-direction, the clamp is fitted by supplying the clamping force in the second X-direction, which the clamp is fitted in the slot as shown in Fig. 10” is not substantiated by the Ng reference. The reasons for rejection as set forth above fail to set forth a *prima facie* basis to reject claim 21 as discussed below.

First, FIG. 9 of Ng does not illustrate the subject matter set forth on page 5 of the Office Action. FIG. 9 illustrates a retention portion 192 and a deflection portion 190 moveable in a Y-direction (194) as illustrated by the arrows in FIG. 9. FIG. 9 only includes arrows in the Y-direction (194). There are NO arrows in the X-direction or description of force or movement of the retention portion 192 or deflection portion 190 in the X-direction with respect to FIG. 9. Thus, the statement on page 5 of the Office Action that FIG. 9 of Ng discloses a clamping force in the X-direction and an outward force in the Y-direction are not substantiated by Ng and thus fail to establish a *prima facie* basis to reject claim 21.

Second, FIGS. 10-12 and col. 7, lines 13-col. 8, line 38 do NOT teach the claimed subject matter quoted above. FIGS. 8-9 of Ng illustrate operation of a deflection portion 190 to clamp a disc clamp 136 to a motor hub 138. As shown in FIG. 8, deflection portion 190 moves along Y-axis 194 to impart a deflection force to a peripheral portion of the disc clamp to enlarge the mounting aperture 140 of the disc clamp. (col. 7, lines 34-45). Mounting tool 188 is lowered via movement along the Y-axis 194 as illustrated in FIG. 9. (col. 7, lines 53-63). In FIG. 9 of Ng, the force imparted by the deflection portion 190 and mounting tool 188 are supplied in the same direction along the Y-axis (194) and not in a first direction and a second direction generally transverse to the first direction as claimed.

As shown in FIG. 7 of Ng, a retention portion 192 holds the disc clamp while the deflection portion 190 applies the deflection force to enlarge the mounting aperture 140 of the disc clamp (col. 7, lines 32-38). The deflection portion 190 is retracted from the hub 138 along the Y-axis as shown in FIG. 10 to disengage the clamp to allow the clamp to pressingly engage a retention surface of the motor hub 138. (col. 7, lines 52-64). In Ng, deflection portion 190 moves along the Y-axis NOT the X-axis to disengage the clamp so that the clamp pressingly engages the motor hub 138 to clamp the storage media. (col. 7, lines 55-64). As shown in FIG. 11, the retention portion 192 is moved outwardly from clamp 136 along X-axis 196 and along the Y-axis as shown in FIG. 12 to release the clamp following clamping engagement with the motor hub 138. Movement of the retention portion 192 as illustrated in FIGS. 11-12 does not supply a clamping force to disengage the inner portion of the clamp thereby reducing the opening to install the clamp over a flange as claimed.

Rejection of claim 26 is erroneous since it fails to consider each of the recited claim elements

Claim 26 claims a method as follows:

supplying an outward force in a first direction to an inner portion of a clamp via an assembly tool;

releasing the clamp from the assembly tool by supplying a clamping force in a second direction towards a clamping interface where the second direction is different from the first to install the clamp . . .

Claim 26 was rejected for the reasons discussed above with respect to claim 21 and in addition on the basis that Ng teaches that “the clamping force is supplied while inner portion (190) and outer tools (192) engages the inner and outer portions of the clamp as shown in Fig. 8”. Office Action page 3. Pursuant to MPEP §2143.03, to establish a *prima facie* basis to reject claims under 35 U.S.C. §102, all of the words in a claim must be considered and all of the claim limitations must be taught or suggested by the prior art. The rejection of claim 26 is erroneous, *inter alia*, since the rejection on its face fails to consider each of the recited claim elements.

In claim 26, the clamp is released from an assembly tool by supplying a clamping force in a **second direction towards a clamping interface where the second direction is different**

from the first. Rejection of claim 26 as quoted above on the basis that Ng discloses supplying a clamping force in a second direction generally transverse to the first direction and on that basis that “the clamping force is supplied while inner (190) and outer tools (192) engage the inner and outer portions of the clamp” on its face fails to consider the claim language where the clamping force is supplied in a second direction **towards the clamping interface** different from the first direction. Since the Office Action fails to consider each of the recited claim elements, the rejection must be withdrawn. Additionally, in Ng, the force of the retention portion 190 and mounting tool 188 are supplied in the same direction along the Y-axis as illustrated by arrows in FIGS. 8-9 and in FIGS. 10-12, the retention portion 190 and deflection portion 192 move away from and NOT towards the motor hub 138 or clamping interface as claimed.

Rejection of claim 28 is erroneous for failure to consider each of the recited claim elements

Claim 28 recites a method comprising *inter alia*:

supplying an outward force in a first direction to an inner portion of the clamp;

supplying a clamping force in a second direction to the clamp along an inverted portion of the clamp spaced from the inner and outer edges of the clamp, **where the second direction is different from the first direction and in a direction towards the spindle assembly**;

Claim 28 was rejected for the reasons discussed above with respect to claim 21 and in addition on the basis that “an inverted spring portion (a slopped [sic] tip portion) of the clamp is snap fitting [sic] into the groove of the clamping interface as shown in Fig. 9”. The rejection on its face fails to consider each of the recited claim elements **including supplying a clamping force in a second direction to the clamp where the second direction** is different from the first direction **and in a direction towards the spindle assembly** in the combination claimed. As properly construed, the claimed subject matter is not anticipated by Ng as discussed above.

Rejection of claim 42 is erroneous for failure to consider each of the recited claim elements

Claim 42 is dependent upon claim 26 and additionally recites wherein the step of supplying the outward force comprises **moving the assembly tool in the second direction** to engage the inner portion of the clamp along a sloped surface of the assembly tool **to supply the**

outward force to the inner portion of the clamp **in the first direction**. Claim 42 is rejected as set forth above with respect to claim 21 and further on the basis that Ng discloses engagement of the clamp along a sloped surface to supply the outward force. Regardless of whether Ng discloses engagement of the clamp along a sloped surface to supply an outward force along the Y-axis, the rejection on its face fails to consider the recited claim elements including **moving the assembly tool in the second direction different from the first or Y-direction to supply the outward force in the first direction or Y-direction**. In Ng, deflection in the Y-direction is supplied via movement of the deflection portion 190 in the Y-direction not in a second direction different from the Y-direction as set forth in the claim.

Rejection of claim 44 is erroneous based upon a misconstruction of the claim.

Claim 44 is rejected as discussed above with respect to claim 21 and in addition on the basis that Ng teaches the clamping force is supplied via an assembly tool movable in the second direction toward the spindle assembly as shown in FIGS. 7-9". Office Action, page 4. Claim 44 is dependent upon claim 28 which claims an **outward force in a first direction** and a **clamping force in a second direction** different from the first direction and in a direction towards the spindle assembly. Claim 44 expressly recites the **outward force in the first direction** is supplied via an **assembly tool movable in the second direction**. The Examiner's rejection of claim 44 on the basis that the **clamping force in the second direction** is supplied via an assembly tool movable in the second direction on its face, fails to consider the expressed claim language that the **outward force in the first direction** (not the clamping force in the second direction) is supplied by the assembly tool movable in the second direction and thus fails to establish a *prima facie* basis to reject claim 44. The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,
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